

Appl. No. : 09/618,209
Filed : July 18, 2000

REMARKS

Applicant has the following comments in response to the Office Action.

Discussion of Claim Rejections Under 35 U.S.C. § § 102(b) and 103(a)

In the Office Action, the Examiner rejected Claim 11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,119,162, to Li, et al. (hereinafter "Li"). Claims 1 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of U.S. Patent No. 6,170,014, to Darago, et al. (hereinafter "Darago"). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Darago and further in view of Frank, Jr., et al. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Darago and further in view of U.S. Patent No. 5,875,349, to Fite, et al. Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Darago and further in view of U.S. Patent No. 5,654,905, to Mullholland, et al. Claims 7 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Darago and further in view of U.S. Patent No. 6,373,498, to Abgrall.

One embodiment of Applicant's system is generally directed to a content delivery service. In one embodiment, executable code in a disk controller circuit in a disk drive is manufactured so as to, under the occurrence of a selected condition, initiate execution of a server-contacting program. The disk controller circuit may delay the initiation of the execution of the server contacting program until a predetermined period has lapsed or, alternatively, it may count the number of times a personal computer associated with the disk drive has been booted. After execution, the server-contacting program uses a network address that is stored in the disk drive to contact a content delivery server. The content delivery server then delivers content to the personal computer.

Claims 1 and 11

Turning to the claims, it is seen that independent Claim 1 "*installing firmware in the disk drive to initiate execution* of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server." Independent Claim 11 recites "*a disk drive connectable to*

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the computing subsystem, *the disk drive comprising*: a network address, and a server-contacting program; and *a disk controller circuit in the disk drive that, upon the occurrence of a selected condition, determines to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem* in the personal computer system, wherein execution of the server-contacting program includes using the network address for connecting the personal computer system to the content delivery server.

Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* M.P.E.P. § 2131. Furthermore, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. Applicant respectfully submits that at least one limitation from the above-listed claims is not taught or suggested by the above-listed references.

Li describes a system in which one of a number of LAN networked computers serves as a gateway to an ISP. *See* col. 4, line 61 – col. 5, line 11. According to Li, using server software, any of the computers connected to the LAN can be dynamically selected as the server. *See* col. 5, lines 12-14. The server software is installed on all of the computers that are connected to the LAN. *See* col. 5, lines 17-19. If one of the servers is shut down or disconnected from the network, the other computers select a new server from the available computers. *See* col. 5, lines 27-30.

However, Li fails to teach or suggest installing *firmware* in a disk drive to initiate execution of a server contacting program. In Li, the server software is executed by a central processing unit in the computer and it is not executed in the disk drive itself, i.e., it is not firmware. Since Li fails to teach or suggest at least this limitation, Applicant respectfully submits that Claim 11 is allowable over Li.

Furthermore, Applicant respectfully submits that at least this limitation is not taught or suggested by Darago. Darago is generally directed to a computer architecture for managing courseware in a shared use operating environment. Darago was primarily relied upon for teaching a system for sending, receiving, and display information from a content delivery server. However, Applicant respectfully submits that Darago, like Li, fails to teach or suggest providing *firmware* in a disk drive to initiate execution of a server-contacting program.

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Since the cited references fail to teach or suggest at least the above-limitations in isolation or in combination, Applicant respectfully submits that independent Claims 1 and 11 are in condition for immediate allowance.

Claims 2-10 and 12-19

Since Claims 2-10 and 12-19 each depend on one of Claims 1 and 11, Applicant respectfully submits that these claims are allowable for at least the reasons discussed above and the subject matter of their own limitations.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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